

REMARKS

Claims 1-27 are currently pending in the application. Claims 14-23 stand withdrawn as directed to a non-elected invention. Applicants cancel claim 2 and amend claims 1, 3, 4, 9, 12, 24 and 25 in this Amendment and Response. No claims are added. Claim 1 is amended to incorporate the element(s) of dependent claim 2. Claims 3, 4, 9, 12, 24 and 25 are amended to correct their dependency based on the cancellation of claim 2. Claim 12 is formally amended to provide antecedent basis for a claim term. Support for the amendments to claims 1 and 12 may be found in the specification and claims as filed, *passim*.

Claim Rejection Under 35 U.S.C. § 112

The Examiner rejects claim 12 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts the claim term "contents" lacks sufficient antecedent basis. The Examiner further asserts a lack of clarity in use of the term "level criteria" for the pre-selected carton contents recited in the claim.

Applicants respectfully offer the following traversal. Applicants have amended the term "contents" to read "product contents" in an effort to provide clearer antecedent basis for the term. Claim 12 indicates that the recited master carton contains multiple products. It is these product contents that are referred to later in the claim. Applicants believe the offered amendment fully addresses this aspect of the rejection. As concerns the meaning of "level criteria," Applicants direct the Examiner's attention to the first three lines of page 6 of the specification, where Applicants offer a definition of the term "level." Criteria for, for example, product levels are further described on pages 8-9 of the specification. Applicants respectfully submit that, read in light of the teachings of the specification, use of level criteria in the claimed invention is adequately disclosed and described in the application and capable of understanding by those of ordinary skill in the art. In light of the proposed amendment to claim 12, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 12 under 35 U.S.C. § 112, second paragraph.

Claim Rejections Under 35 U.S.C. § 102(e)

The Examiner rejects claims 1, 2, 6, 8, 9 and 13 under 35 U.S.C. § 102(e) as anticipated by the disclosure of U.S. Patent No. 6,922,701 (Ananian et al.). The Examiner asserts the following with respect to former independent claim 1 and dependent claim 2:

"Ananian et al. discloses the claimed portable system comprising a host system, and a field system that can communicate with the host system, the portable system capable of:

receiving engineering information related to at least a portion of a construction project from a database or spreadsheet (see database 40), formatting the information into a suitable format to be used for one or more of printing identification product, preparing work packages, tracking materials used, and reporting materials used for the construction project (the system of Ananian receives plan sets submitted by the client, column 2, lines 43+, which Examiner construes to be "engineering information," formats the information into a format for the claimed uses when the plan set is converted to a profile data set by the profiling engine, column 2, line 62+;

(regarding claim 2) generating orders for identification products and managing fulfillment of the orders (column 9, lines 9+ disclose where every item ordered is uniquely identified with a unique identifier to manage the order and items)." (Office Action at Paragraph 5).

Applicants respectfully offer the following traversal. Although not acquiescing to the Examiner's application of the disclosure of Ananian to former independent claim 1, Applicants have amended claim 1 to incorporate the element(s) of dependent claim 2. Applicants assert that the Ananian reference fails to teach or suggest a portable system, as defined in amended claim 1, that is capable of receiving engineering information related to a portion of a construction project, formatting the information into a suitable format for specified uses, generating product orders and managing order fulfillment.

Ananian et al. disclose a method of generating an interactive profile system related to certain real estate and construction assets and projects. For at least construction applications and uses, the Ananian method centers on the creation and generation of an interactive profile of a building. (*See, e.g.*, col. 2, lines 36-43 and Figures 2-3). This profile is generated by the input of a plan or physical description (usually in a CAD format) into a profile system. (*See* col. 2, lines 43-54; col. 5, line 12 to col. 6, line 36). The plan is expanded and converted into a profile data set using a profiling engine. The profile data set is compiled to an enhanced profile in which a plurality of components are interrelated and assigned unique descriptors. (*See, e.g.*, col. 3, lines

9-21; col. 8, line 29 to col. 11, line 42). The enhanced profile may be tied to or coordinated with auxiliary external databases, including those containing regional building codes, material pricing, cost estimators, *etc.* (See, e.g., col. 8, lines 47-53; col. 11, lines 4-20). The enhanced profile may also be queried by a user to generate reports, such as material listings and building schedules. (See, e.g., col. 13, line 13 to col. 14, line 44; col. 21, line 65 to col. 22, line 6). The Ananian method's goal is stated to provide an improved interaction between a client and their contracted building professionals throughout the construction process and to provide a streamlined and efficient manner for incorporating design and specification changes during progression of the project. (See, e.g., col. 2, lines 1-17).

Importantly, however, the Ananian method neither discloses nor discusses a manner by which the ordering and order fulfillment of required products are managed and accomplished. The only mention of supply ordering comes by way of a single sentence at column 8, lines 60-62, in discussion of the potential linkage of the enhanced profile with external databases: "Pricing and ordering of appliances, furniture, fixtures and accessory items may also be provided in a furnishings database." This mere mention of connection to an external database does not teach or suggest the invention recited in independent claim 1, in which a single portable system receives engineering information, formats the information, generates product orders based on the information and manages order fulfillment. Indeed such an order fulfillment purpose lies far from the stated central purpose of the Ananian method which is directed to the interaction of a client and a contracted professional.

The Examiner points to column 9, line 9⁺ as disclosing "where every item ordered is uniquely identified with a unique identifier to manage the order and items." Applicants respectfully assert the Examiner reads this passage much too broadly. The passage does discuss the assignment of unique identifying descriptor tags to component parts of a building, and it discusses use of the profiling engine to link multiple building components and define interrelationships among them. It does not, however, mention any capability to generate product orders or to manage order fulfillment. For at least this reason, Applicants assert that amended claim 1 is patentable over Ananian under 35 U.S.C. § 102(e). Applicants therefore respectfully request reconsideration and withdrawal of the rejection.

Claim Rejections Under 35 U.S.C § 103(a)

The Examiner rejects claims 3 and 10 under 35 U.S.C. § 103(a) as obvious over Ananian in view of U.S. Patent No. 7,225,249 (Barry et al.). According to the Examiner: "Ananian et al. discloses the claimed device but is silent regarding generating a termination report. Barry et al. discloses that it is known in the art to provide termination reports in order to report important information, see paragraph (265). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Ananian et al. with the termination reports of Barry et al., in order to report important information."

Applicants respectfully traverse the rejection. As detailed above, Ananian fails to teach or suggest a system as described in amended independent claim 1. Barry et al. fails to cure the fundamental defect in Ananian, and the Examiner does not rely on it for such purpose. Regardless of the propriety of combining the teachings of the Ananian and Barry references for disclosure of the features of dependent claims 3 and 10, each of these claims depend on claim 1 and are patentable for the same reasons. Applicants respectfully request reconsideration and withdrawal of the rejection in light of the arguments with respect to independent claim 1.

The Examiner rejects dependent claims 4, 7, 11, 12 and 24-27 under 35 U.S.C. § 103(a) as obvious over Ananian in view of U.S. Patent No. 6,508,900 (Kendall et al). The Examiner also rejects dependent claim 5 under 35 U.S.C. § 103(a) as obvious over Ananian in view of U.S. Patent Application Publication No. 2002/0198755 A1 (Birkner et al.). In each of these rejections, the Examiner asserts that the secondary reference discloses the additional features recited in the rejected dependent claim.

Applicants respectfully traverse these rejections on the basis of the patentability of amended independent claim 1. Neither of the cited secondary references cures the fundamental defect in the teachings of the Ananian reference, and the Examiner does not rely on them for such. Because independent claim 1 is patentable for the reasons detailed above, each of the rejected dependent claims (that depend directly or indirectly on claim 1) are necessarily patentable for the same reasons. Applicants therefore respectfully request reconsideration and withdrawal of each of the rejections under 35 U.S.C. § 103(a).

Conclusion

In view of the accompanying amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the various claim rejections set forth in the outstanding Office Action. The Examiner is invited to contact Applicants' undersigned attorney if doing so would resolve any or all remaining issues with this application.

Respectfully submitted,

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Date

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